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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,785	04/09/1999	JAMES G. HANKO	843161-189	9037
23879	7590	07/12/2005		
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			EXAMINER BRIER, JEFFERY A	
			ART UNIT 2672	PAPER NUMBER

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/289,785

Applicant(s)

HANKO, JAMES G.

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,14-30,34-41 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-10,35-37 and 44 is/are allowed.
- 6) ☒ Claim(s) 11,14-30,34,38-41,43 and 45-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 6/20/2005 has been entered.
2. The indication of allowable subject matter of claims 21-30, 34, 41, 43, and 46-51 is withdrawn based upon the discovery of two documents Salesky et al., PreGrant Publication No. 2004/0080504 published on April 29, 2004 with a filing date of March 25, 1997 with a provisional filing date of March 26, 1996 and Hawkins, PreGrant Publication No. 2001/0032254 published on October 18, 2001 with a filing date of May 29, 1998. Salesky is used in the following rejection.
3. The indication of allowable subject matter of claims 11, 14-20, 38-40, and 45 is withdrawn for technical reasons based upon 35 USC 112 and 101 which are further elaborated below.

Allowable Subject Matter

4. Claims 11, 14-20, 38-40, and 45 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 101 set forth in this Office action. Claims 23-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claims 1, 4-10, 35-37, and 44 are allowed. The prior art of record fails to teach or suggest wherein said server is configured to perform the mapping step found in the last three lines of claim 1 and last four line of claim 11.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 11, 14-20, 38-40, and 45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim is a program per se due to indefinite claim limitations which will be explained below. Lines 1-3 claim a program for image processing but do not claim a computer is performing the processing. Lines 4 to the end of this claim claim computer readable code but do not clearly claim this code is the same code present in the computer usable medium and thus also claim a program per se.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11, 14-20, 38-40, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 4 to the end of this claim claim computer readable code but do not clearly claim this code is the same code present in the computer usable medium. At lines 4, 7, 10, 12, and 18 applicant should consider amending those lines. With line 4 as an example applicant could amend this

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line to claim "computer readable code embodied in said computer usable medium
causing ~~to cause~~ a server to obtain image data, the" (underlining shows possible
additions, strikethrough shows possible deletions).

9. Claims 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being
incomplete for omitting essential steps, such omission amounting to a gap between the
steps. See MPEP § 2172.01. The omitted steps are: the mapping steps found in claim
1 at the last three lines of claim 1.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply
with the written description requirement. The claim(s) contains subject matter which
was not described in the specification in such a way as to reasonably convey to one
skilled in the relevant art that the inventor(s), at the time the application was filed, had
possession of the claimed invention. This non original claim claims the thin client is a
stateless device. A review of the specification including the originally filed claims do
not convey that applicant had possession of a stateless device. All devices performing
a function would have states.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 21-30, 34, 41, 43, and 46-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Salesky et al., PreGrant Publication No. 2004/0080504 published on April 29, 2004 with a filing date of March 25, 1997 with a provisional filing date of March 26, 1996. Paragraphs 0093, 0108, 0109, and 0110 discuss clipping at the server, paragraph 0109, before transmitting the image without conversion, this limitation was added by applicant to overcome a digital to analog to digital system see response filed on 9/03/2003, and discuss having the client scale the image to fit the display, paragraph 0108. Figure 6A and B illustrates clipping at the server.

Claim 21:

Salesky teaches an apparatus comprising:

a network (*see the title, abstract*);

a thin client (*applicant's specification does not define thin client and on page 8 lines 3-7 of applicant specification applicant seems to equate thin client with terminal. The response filed on 9/03/2003 at page 11 defines thin clients as: A thin client is a small,*

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stateless, "plug and work" desktop computer whose main function is to process all input and output for the user and to manage communication with at least one server. All other computational tasks (or services) for the user are performed on the server, which is shared amongst a community of thin clients via a digital network. Thus, computational tasks (e.g., clipping before scaling) that normally would be performed by the client are off-loaded to the server, permitting simplification of the client (i.e., the thin client) on the digital network. Salesky in paragraph 0010 discusses a variety of attendee clients with many of the listed devices that may be used as clients being thin clients such as: personal computers, , X-terminals, cable or satellite TV set-top boxes ("STBs"), personal digital assistants ("PDAs"), game playing machines, WebTV.TM.s, network computers ("NCs"), Infopads, visual telephones, and other existing or as yet undeveloped input and/or output devices.);

a server configured to obtain image data and transmit clipped image data over said network (conference server 14 is connected to a network and paragraph 0109 describes the server as clipping the image so offscreen portions of the image need not be transmitted via the network from the server to the client.); and

a receiver on said thin client configured to receive said clipped image data without conversion (This was added to overcome a reference in the 09/03/2003 response and it was argued on page 14 that this limitation overcomes a system that converts digital to analog then back to digital.) over said network, said receiver further configured to scale said clipped image data for display (Paragraph 0108 discusses the client changing the size of the image received by the client.).

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Claim 22:

Salesky teaches the apparatus of Claim 21, further comprising a clip-list (*A list in the server is necessary to instruct the server to clip the image.*)

comprising at least one clipping region, wherein said server is configured to map said at least one clipping region to said image data to obtain said clipped image data (*At least one clip region, 56, 57 may be seen in figures 6A and 6B being mapped to the image to be clipped.*).

Claim 27:

Salesky teaches the apparatus of Claim 22, wherein said server is configured to map a plurality of clipping regions (*blocks 56, 57*) to a plurality of regions of image data (*blocks 56, 57*).

Claim 28:

Salesky teaches the apparatus of Claim 27, wherein said server is configured to individually transmit said plurality of regions of image data to said receiver (*The server transmits each block 56, 57 that is intended to be transmitted to the client.*).

Claim 29:

Salesky teaches the apparatus of Claim 27, wherein said receiver is configured to independently scale up said plurality of regions of image data to fill respective regions of

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a display (*Slesky teaches changing the size of the image which includes both scale down and scale up.*).

Claim 30:

Salesky teaches the apparatus of Claim 29, wherein said receiver is configured to apply independent scale factors to said regions of image data and wherein said scale factors reduce scaling along a horizontal axis and increase scaling along a vertical axis (*Slesky teaches changing the size of the image which includes both scale down and scale up and combinations of both.*).

Claim 41:

Salesky teaches the method of Claim 21, wherein said computer network is a shared network (*See figure 1 which shows many attended clients connected to one conference server.*), low bandwidth network (*Paragraph 0135 discusses various networks including a low speed network which is a low bandwidth network.*).

Claim 46:

Salesky teaches the method of Claim 41, wherein said computer network is a digital network (*Paragraph 0105 discusses processing digital data in the client by a DSP and discusses MPEG all of which manifest that a digital network is present.*).

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Claim 47:

Salesky teaches the apparatus of Claim 21, wherein said thin client provides a network interface to a user and wherein said server provides a plurality of computational services removed from said thin client to said user (*Since this document discloses using thin clients then inherently the claimed functions of the server are taught by this reference see figure 11 and paragraph 0179*).

Claim 48:

Salesky teaches the apparatus of Claim 47, wherein said plurality of computational services comprise a computational power (*See the discussion of claim 47 and the processes performed in the server for the client use computational power.*) and a state maintenance for said thin client (*The service provided by the server discussed in paragraph 0179 constitutes state maintenance.*).

Claim 50:

Salesky teaches the apparatus of Claim 21, wherein said image data is clipped only at said server (*See the discussion given for claim 21 which describes the server not the client as clipping the image prior to transmitting the image to the client.*) and said clipped image data is scaled only at said thin client (*See the discussion given for claim 21 which describes the client as scaling the image prior to displaying the image on the client's display..*) in order to provide greater image data transmission efficiency from

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said server to said thin client via said network (*Clipping at the server saves bandwidth by transmitting less information from the server to the client.*).

Claim 51:

Salesky teaches the apparatus of Claim 21, further comprising a clip- list identifying visible region displayed on the client (*A list in the server is necessary to instruct the server to clip the image.*), wherein said server is configured to obtain a copy of said clip-list (*A copy of the list must be obtained by the server to instruct the server to clip the image.*) and wherein said copy of said clip-list residing on said server is used by said server to obtain said clipped image data from said obtained image data (*A copy of the list is used to instruct the server to clip the image.*).

Claim 34:

Salesky teaches an apparatus comprising:

means on a server for obtaining image data, the image data defining a complete image having a horizontal extent and a vertical extent when rendered in a display (*See the discussion given for claim 21. The means of Salesky is the same as or equivalent to the means used by applicant because both used programmed hardware to obtain the image.*);

means on a server for clipping said image data to obtain clipped image data, the clipped image data representing a portion of the complete image when rendered in the

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display (*See the discussion given for claim 21. The means of Salesky is the same as or equivalent to the means used by applicant because both used programmed hardware to clip the image that will be displayed on the client's display.*);

means for transmitting said clipped image data via a computer network from a transmitter on said server without conversion to a receiver on a thin client (*See the discussion given for claim 21. The means of Salesky is the same as or equivalent to the means used by applicant because both used programmed hardware to transmit the clipped image to the client.*),

wherein said computer network is a shared, low bandwidth network (*See the discussion of claims 36 and 37.*); and

means, at said receiver, for scaling said clipped image data for display (*See the discussion given for claim 21. The means of Salesky is the same as or equivalent to the means used by applicant because both used programmed hardware to scale the clipped image at the client.*).

Claim 43:

Salesky teaches the method of Claim 34, wherein said computer network is a digital network (*Paragraph 0105 discusses processing digital data in the client by a DSP and discusses MPEG all of which manifest that a digital network is present.*).

Prior Art

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

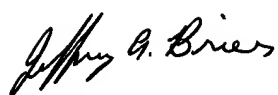
Hawkins, PreGrant Publication No. 2001/0032254 published on October 18, 2001 with a filing date of May 29, 1998. Hawkins discusses scaling at a proxy server transmitting the image data and scaling the image before transmission to the hand held client. See paragraphs 0102 and 0165.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Jeffery A. Brier". The signature is written in a cursive style with a large, stylized "J" and "B".

Jeffery A Brier
Primary Examiner
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